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In re Application of :  
PERICAK-VANCE *et al* :  
U.S. Application No.: 10/520,695 :  
PCT No.: PCT/US03/21963 :  
Int. Filing Date: 11 July 2003 :  
Priority Date: 12 July 2003 :  
Attorney's Docket No.: 5405.264 :  
For: GENETIC SUSCEPTIBILITY GENES :  
FOR ASTHMA AND ATOPY AND :  
ASTHMA-RELATED AND ATOPIC- :  
RELATED PHENOTYPES :

## DECISION

This is a decision on the request to add two inventors and delete one inventor in the above-captioned application filed 14 November 2005. This is treated under 37 CFR 1.497(d).

## BACKGROUND

On 12 July 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 14 November 2005, applicant filed a response which was accompanied by, *inter alia*, a request to add and delete named inventors; a two-month extension request and fee; a surcharge fee; the processing fee; an executed declaration listing four inventors; statements from two inventors being added and one inventor being deleted; a consent of assignee statement; and authorization to charge any additional fees to Deposit Account No. 50-0220.

## DISCUSSION

Applicants request to add Marcy C. Speer and Michael A. Hauser and remove Jonathan L. Haines as inventors in the above-captioned application. 37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)). 37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Applicants provided the requisite statements from the two inventors being added and one inventor being deleted that the error in inventorship was "inadvertent and occurred without any deceptive intent" on their part. The processing fee of \$130.00 was paid. Items (1) and (2) above, are satisfied.

Applicants also provided a consent of the assignee statement signed by Robert L. Tabor as Vice Chancellor of Duke University. The position of Vice Chancellor is an officer of the university and is presumed to have the apparent authority to sign on its behalf. See MPEP § 324.

However, applicants have not established that Duke University is the assignee of the subject application. Specifically, applicants did not provide a copy of the recorded assignment or state the location of the assignment, e.g. reel and frame number. See 37 CFR 3.73(b)(1). For this reason, item (3) is not yet satisfied.

Therefore, all the requirements of 37 CFR 1.497(d) are not complete.

### **CONCLUSION**

For the reason discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia

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22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink that reads "James Thomson". The signature is written in a cursive style with a large, stylized "J" and "T".

James Thomson

Attorney Advisor

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